

Docket No. F-8335

Ser. No. 10/501,971

**REMARKS**

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Claims 1-8 are pending. Claims 1, 3, 4, 6 and 8 have been amended.

The Examiner has suggested a non-substantive amendment to Claim 6 and Applicant has amended the claim as suggested.

Claims 1-3 are rejected under 35 USC § 102(b) as being anticipated by Sonneville (USPN 3190607). Claim 4 and 5 are rejected under 35 USC § 103(a) as being unpatentable over Sonneville as modified by Mohr (USPN 6488215) where Mohr is cited for teaching the claimed configuration of the two V-shaped, angled bar joists. Claim 1 and 6 are rejected under 35 USC § 103(a) as being unpatentable over Mohr as modified by Sonneville where Sonneville is cited for teaching weld connections between protruding reinforcement parts.

Claim 8 is rejected under 35 USC § 103(a) as being unpatentable over Hayes (USPN 990,650). Claims 1 and 7 are rejected under 35 USC § 103(a) as being unpatentable over Hayes as modified by Scott (USPN 3574898) where Scott is cited for teaching a connector in the form of a pipe section.

Applicant asserts that rejections under 35 USC §102 (b) cannot be maintained unless each claimed element is taught by the cited reference.

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*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim" is found in the cited prior art reference). Moreover, rejections under 35 USC § 103(a) cannot be maintained unless the combined prior art teaches each claimed limitation. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974) (a *prima facie* case of obviousness is established only where the combination of cited references teaches or suggests each limitation in the claim). Furthermore, a rejection under section 103(a) cannot be maintained where the references, as a whole, teach away from the claimed subject matter. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (a "reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"); *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (a reference teaches away when the skilled artisan would be "would be led in a direction divergent from the path taken by the applicant").

Here, the railroad tie recited in claims 1 and 8 is adaptable to different track widths. The exact length of the claimed protruding reinforcements is determined at the building site when the track is fabricated. Accordingly, the claimed ties are not prefabricated as with conventional ties because the desired space between the individual ties is determined at the installation site. The

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assembly occurs via spacing with a gauge the individual tie segments including the protruding reinforcements and subsequent welding of adjacently positioned protruding reinforcements. As the length of the protruding reinforcements is determined at the building site, it is possible to compensate for larger tolerances when applying the claimed ties at track switch points.

In comparison with the claimed invention, Sonneville fails to disclose a tie having protruding reinforcements which enable assembly at the installation site to compensate for desired spacing between individual tie segments depending on the track width. Rather, the reference teaches two L-shaped longitudinally extending rods connecting adjacent concrete blocks. The length of the rods, and therefore the spacing of the adjacent blocks, is fixed. Accordingly, it is not possible to adjust the rods or the spacing of the blocks at the building site and rather the reference teaches away from providing the ability to assemble at the installation site by determining at the site the desired spacing between the individual tie segments so as to compensate for differing track widths. Furthermore, the reference fails to disclose welded connections in the longitudinal direction as recited in the claims. Rather, the welding identified by the Examiner connects rods which are otherwise, without the assistance of the welds, connected to adjacent blocks. That is, the welding in

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Sonneville does not *itself* connect longitudinally adjacent concrete blocks as with the claimed invention.

Turning to Mohr, the reference fails to disclose connections which are capable of being welded at the installation site by the connection of longitudinally adjacent concrete blocks so as to produce ties which accommodate differing track widths. Mohr teaches away from the claimed invention by providing prefabricated ties so that adjustment at the building sight as with the claimed invention is not possible.

As to Hayes and Scott, neither reference teaches the structure of amended claims 1 and 8, including the configuration of the bar joists.

Based on the above analysis, the references, separately or combined, fail to teach each claimed limitation so that the claimed invention is neither anticipated by nor rendered unpatentable by the cited art.

Applicant respectfully requests a one month extension of time for responding to the Office Action. The fee of \$120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

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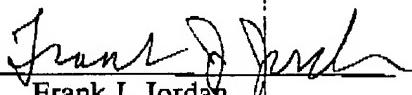
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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
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